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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/993,699	12/18/97	HANEY	D HAN301F

QM11/0805

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EXAMINER	
ROSE, R	
ART UNIT	PAPER NUMBER
3723	

DATE MAILED: 08/05/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/993,699

Applicant(s)
Haney

Examiner
Robert Rose

Group Art Unit
3723



☒ Responsive to communication(s) filed on 4-17-98, 6-26-98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

1. Receipt is acknowledged of Applicant's Prior Art Statements, filed April 17, 1998.
2. Receipt is acknowledged of Applicant's Preliminary Amendment, filed June 26, 1998.
3. This application has been filed with formal drawings which are approved by the draftsman.
4. Claims 14-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 14, lines 10-11 the recitation of the platen moving in a translational orbit when the two shafts are rotated is without supporting structure, in that no means to transmit the rotational motion of the shafts to a translational orbital motion of the platen is recited, and therefore is deemed incomplete. What structure accomplishes the recited change of motion? How is the translational orbit derived from rotation of the second and third shafts? In claim 15, line 2 the phrase "the second shaft" and "the third shaft" lack antecedent support. In claim 16, line 3 the phrase "the second and third shafts" is without a proper antecedent basis. These shafts should be properly identified in claim 14. In claim 14, line 1 Applicant recites an apparatus for sanding but provides no abrasive element capable of performing the sanding function, thus the claim is deemed incomplete.
5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467,

Art Unit:

114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of prior U.S. Patent No. 5702287. This is a double patenting rejection.

The claims are identical except for the omission of the words "sheet of" before the term "sandpaper". However, the term "sandpaper" is deemed to encompass the limitation of a "sheet".

7. Claims 14-16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2, 4-5, and 10-11 of prior U.S. Patent No. 5443414. This is a double patenting rejection.

8. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (703) 308-1360.

rr

July 29, 1998.

ROBERT A. ROSE
PRIMARY EXAMINER
ART UNIT 023

